

value. Claim 21 defines an apparatus for measuring and recording coating thickness measurements including, among other elements, means for recording in the electronic memory a plurality of descriptive data so that each descriptive data is associated with a respective one of the coating thickness values and provides information concerning the respective one coating thickness value.

Turning attention to Exhibit K, which is a two page document providing a very brief description of the 365 coating thickness data analyzer, there does not appear to be any description at all of the claimed invention. Specifically, the document indicates that the 365 can provide a statistical analysis, and that the user can define and program the method of data collection and select the form of data presentation. However, there is no teaching of the second recording step of claim 1 or the second means for recording of claim 21. Exhibit K does not teach or suggest the recording in an electronic memory of a plurality of descriptive data, and that each descriptive data is associated with a respective one of a coating thickness value. Accordingly, the Examiner is respectfully requested to provide greater detail concerning the rejection, or else withdraw the rejection of claims 1 and 21 based on Exhibit K.

Claim 2 depends from claim 1, and thus is also patentable over the Elcometer 365 brochure.

Claim 31 defines a method of recording coating thickness measurements with an electronic device that includes a probe connected to an electronic memory, the method includes the steps of recording coating thickness values in an electronic memory and *after* recording the coating thickness value in the electronic memory inputting to the electronic

device descriptive data concerning the coating thickness value. The Exhibit K brochure clearly does not teach or suggest the step of inputting descriptive data *after* recording the coating thickness values in an electronic memory. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 31.

Claims 3-10, 16, 22-23, and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Exhibit K. Claim 10 defines an apparatus for measuring a coating thickness, which includes a probe which generates a first signal representative of a measured coating thickness, and a PCMCIA card connected to the probe and which receives the first signal from the probe. The PCMCIA card includes means for converting the first signal into a second signal, which is compatible with a standard PCMCIA output format. With regard to all aspects of the PCMCIA card and PCMCIA format, the Examiner simply alleges that such art is considered well known. In accordance with Section 2144.03 of the Manual of Patent Examining Procedure, the Examiner is respectfully requested to either withdraw the rejection or cite a reference supporting the conclusions made by the Examiner concerning such alleged well known art.

Applicants further submit that the Examiner has not provided adequate motivation for modifying the teachings of Exhibit K with the allegedly known PCMCIA technology. In addition to failing to provide adequate motivation, the Examiner has not provided any teaching or explanation as to how the teachings of Exhibit K would be modified so that it could be combined with the allegedly well known PCMCIA technology.

In the event that the Examiner persists with this rejection, the Examiner is not only requested to provide evidence that the PCMCIA technology was known in the art, but also

the Examiner is requested to provide the alleged motivation to modify the Exhibit K technology, as well as additional details concerning how the modification would take place and how the modified structure would function.

Absent such further information, the Examiner is requested to withdraw the rejection of claim 10 based on Exhibit K.

Claims 3-9 depend from claim 1, and are thus patentable over Exhibit K at least for the reasons set forth above with respect to claim 1.

Claim 16 depends from claim 10, and is thus also patentable over Exhibit K at least for the reasons set forth above with respect to claim 10. Claims 22 and 26 depend from claim 21, and claim 23 depends from claim 1. Accordingly, those claims are patentable over Exhibit K at least for the reasons set forth above with respect to claims 1 and 21.

Furthermore, Applicants reserve the right to challenge the accuracy of the Affidavit of Peter Baldwin at a later time, if necessary and appropriate. In particular, Applicants reserve the right to challenge whether or not Exhibit K is in fact prior art to the present application.

***Schlesinger in view of Koch:***

Claims 11-14 have been rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,079,237, hereinafter "Schlesinger", in view of U.S. Patent No. 5,293,132, hereinafter "Koch '132". In the prosecution of the original application that led to U.S. Patent No. 5,930,744, claims 11-12 were rejected over this combination in an Office Action dated March 5, 1997. A response to the rejection was filed on April 23,

1997. In response, the Examiner withdrew the rejection. Note the Examiner's Statement of Reasons for Allowance in the Notice of Allowability dated May 22, 1997. Thus, these issues have already been discussed on the record. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 11-12 at least for the reasons set forth clearly in the record.

Similar issues pertain to claims 13-14 which were also rejected in the pending application (08/529,137), and after a written exchange, the rejections were withdrawn. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 13 and 14 at least for the reasons set forth earlier in the prosecution of the application. Note the Examiner's Statement of Reasons for Allowance in the Notice of Allowability dated May 22, 1997.

***Schlesinger in view of Nix:***

Claim 15 has been rejected under 35 U.S.C. § 103 as being unpatentable over Schlesinger in view of U.S. Patent No. 5,467,014, hereinafter "Nix".

Similarly, this rejection was made in the Official Action dated March 5, 1997. After the submission of remarks by Applicant, the rejection was withdrawn. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 15 at least for the reasons already established in the record of this application.

***Schlesinger in view of Rosenberg:***

Claims 17-20 have been rejected under 35 U.S.C. § 103 as being unpatentable over Schlesinger in view of U.S. Patent No. 6,429,846, hereinafter "Rosenberg". However, the

present application has an effective U.S. filing date of September 15, 1995. Since the earliest effective filing date of Rosenberg is June 23, 1998, Rosenberg is not prior art with regard to the present application. Accordingly, the Examiner is respectfully requested to reconsider and withdrawn the rejection based on Schlesinger and Rosenberg.

***Claims 23-30 and 32-45:***

The Examiner appears to be rejecting claims 23-30 and 32-45 over the prior art. However, the Examiner has not provided sufficient information to which a reply can be made. Specifically, the Examiner has not indicated whether the claims are rejected under § 102 or § 103. In addition, the Examiner has not identified which prior art is applied to the claims, and more particularly, has not identified which portions of which prior art references correspond to each of the elements of the claim. Accordingly, in the event that the Examiner persists with a rejection of claims 23-30 and 32-45, the Examiner is respectfully requested to provide sufficient information so that Applicants can formulate a proper response.

Nevertheless, the following information is relevant to claims 23-30 and 32-45.

Specifically, claims 23-30 are dependent claims that depend from claims 1, 21, and 31. The patentability of the independent claims 1, 21 and 31 has been discussed above. Accordingly, claims 23-30 are in condition for allowance at least for the reasons set forth above with respect to claims 1, 21 and 31.

Claims 32-38 depend from claim 31, and are thus patentable over the prior art at least for the reasons set forth above with respect to claim 31. Note, as set forth above, that claim 31 includes the term "after" in paragraph (c).

Claim 39 is an independent claim which includes elements not included in any of the rejections set forth by the Examiner. Accordingly, the Examiner has not provided any details concerning the basis for the rejection of claim 39. Claims 40 and 41 depend from claim 39. Accordingly, the Examiner is also respectfully requested to either provide greater details of the rejection or withdraw the rejection.

Claim 42 is an independent claim defining an apparatus that also includes elements that are not discussed in any of the rejections set forth by the Examiner. Claims 43-45 depend from claim 42. Accordingly, the Examiner is also respectfully requested to either provide greater details of the rejection or withdraw the rejection.

Accordingly, in view of the foregoing remarks, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Attorney's Docket No. 007325-077  
Application No. 09/542,640  
Page 8

Applicants note the long period of time which occurred between the filing of the last Response and the outstanding Official Action, and respectfully request that the Examiner take action on this case at the earliest possible convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: 8/13/03

By: William C. Rowland  
William C. Rowland  
Registration No. 30,888

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620